

REMARKS

This application has been reviewed in light of the FINAL REJECTION mailed September 14, 2006. Reconsideration of this application in view of the below remarks is respectfully requested. Claims 1, 3, 5-18, 20-21 and 23-31 are currently pending with Claims 1, 3, 6, 7, 8, 11, 16, 18, 23, 24, 25, 26, 28 and 29 being in independent form. Claims 1, 6-7, 11-15, 23-24 and 26-17 have been previously withdrawn. By the present amendment, Claim 18 has been amended. No new subject matter has been introduced into the disclosure by way of the present amendment.

I. Objection to Claim 18 for Informalities

The Examiner has identified a typographical error in Claim 18 that requires correction. Specifically, the preamble of Claim 18 recites: "User user for a mobile communications system capable of handover from an active network with which user equipment is in communication to another network comprising..." However, The preamble should recite: "User equipment for a mobile communications system capable of handover from an active network with which user equipment is in communication to another network comprising..." In response, Claim 18 has been amended to correct the error.

II. Rejection of Claims 28 – 31 Under 35 U.S.C. § 102(e)

Claims 28 – 31 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,148,197 issued to Bridges et al.

Bridges et al. discloses a mobile station receiving a wireless carrier's identity, and comparing the received wireless carrier's identity with preferred wireless identities that are maintained in the mobile station. (See: col. 6, line 66 to col. 7, line 5).

The mobile station disclosed in Bridges et al. compares the received single identity against the plurality of identities maintained on the mobile station. Consequently, the mobile

station of Bridges et al. does not compare a received list containing a plurality of network identifiers against a second list, which includes at least one network identifier, and is stored on the user equipment to identify at least one network for handover, as recited in Applicant's Claim 28, and similarly recited in Claims 3, 8, 16, 18, 25 and 29.

Contrary to the assertion in the present Office Action, the Bridges et al. passages cited, namely col. 12, lines 66 – 67 and col. 13, 34 – 38, do not disclose Applicant's claimed first list including a plurality of network identifiers. The cited passages disclose that in situations where multiple service providers exist in a given area, the PSL/IRDB stored on a mobile station may comprise a table of multiple SIDs and/or SOC's and their corresponding frequency bands. (See: Bridges et al.: col. 12, lines 35 – 67). Thus, this list is equivalent to Applicant's second list that is stored in the mobile station, because no disclosure is provided in Bridges et al. that the table is a received list

It is well-settled by the Courts that "[A]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company, et al., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984).

Therefore, as demonstrated above, because Bridges et al. does not disclose each and every element recited in the present claims, Applicant respectfully submits that the rejection has been obviated. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 28 – 31 under 35 U.S.C. § 102(e).

III. Rejection of Claims 3 and 25 Under 35 U.S.C. § 103(a)

Claims 3 and 25 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,940,761 issued to Tiedemann, Jr. et al. in view of Bridges et al.

As indicated above, Bridges et al. does not properly disclose or suggest transmitting to the user equipment a first list having a plurality of unique network identifiers, as recited in Applicant's Claim 3; or means for receiving by a user equipment a first list including a plurality of unique network identifiers, as recited in Claim 25.

Tiedemann, Jr. et al. teaches a method for performing mobile assisted handoff between communication systems having a system preference table. However, Tiedemann, Jr. et al. does not overcome the above-identified deficiencies in Bridges et al. Specifically, Tiedemann, Jr. et al. does not disclose or suggest transmitting to, or receiving by, a user equipment a first list including a plurality of unique network identifiers. Thus, Tiedemann, Jr. et al. and Bridges et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.

Therefore, for at least the reasons given above, Claims 3 and 25 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 3 and 25 under 35 U.S.C. § 103(a) over Tiedemann, Jr. et al. in view of Bridges et al.

IV. Rejection of Claims 16 - 18 and 20 Under 35 U.S.C. § 103(a)

Claims 16 - 18 and 20 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 6,223,030 issued to Van Den Heuvel et al. in view of Bridges et al.

As presented above, Bridges et al. does not properly disclose or suggest means for receiving a first list from the active network, the first list having a plurality of unique network identifiers, as recited in Claims 16 and 18.

Van Den Heuvel et al. fails to overcome the deficiencies identified in Bridges et al. Specifically, Van Den Heuvel et al. does not disclose or suggest means for receiving a first list

from the active network, the first list having a plurality of unique network identifiers. Thus, Van Den Heuvel et al. and Bridges et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.

Therefore, for at least the reasons given above, Claims 16 – 18 and 20 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejection with respect to Claims 16 – 18 and 20 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al.

V. Rejection of Claims 5 and 8 – 10 Under 35 U.S.C. § 103(a)

Claim 5 is rejected under 35 U.S.C. §103(a) as allegedly obvious over Tiedemann, Jr. et al. in view of Bridges et al., and further in view of U.S. Patent No. 6,272,315 issued to Chang et al.; and Claims 8 – 10 are rejected under 35 U.S.C. §103(a) as allegedly obvious over Van Den Heuvel et al. in view of Bridges et al., and further in view of Chang et al.

Chang et al. discloses a mobile satellite system and terrestrial wireless system networking technique for switching a mobile unit between a mobile satellite system mode and a terrestrial wireless system mode. Additionally, Chang et al. teaches adding a system ID of a network to the bottom of a list of system Ids stored in a memory of a mobile terminal. However, Chang et al. fails to overcome the above-identified deficiencies present in Tiedemann, Jr. et al., Van Den Heuvel et al. and Bridges et al. Thus, Tiedemann, Jr. et al., Van Den Heuvel et al., Bridges et al., Chang et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.

Therefore, for at least the reasons given above, Claims 5 and 8 – 10 are believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejections with respect to Claim 5 under 35 U.S.C. §

103(a) over Tiedemann, Jr. et al. in view of Bridges et al. and further in view of Chang et al., and Claims 8 – 10 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al. and further in view of Chang et al.

VI. Rejection of Claim 21 Under 35 U.S.C. § 103(a)

Claim 21 under 35 U.S.C. §103(a) as allegedly obvious over Van Den Heuvel et al. in view of Bridges et al, in further view of U.S. Patent No. 6,584,116 issued to Gourgue et al. Claim 21 depends from Independent Claim 16 and thus includes the limitations recited in that independent claim.

Gourgue et al. discloses a UMTS network and a GSM network, and a method of handover to a GSM network from a UMTS network during a call originating in a UMTS network. However, Gourgue et al. fails to overcome the above-identified deficiencies present in Van Den Heuvel et al. and Bridges et al. Thus, Gourgue et al., Van Den Heuvel et al. and Bridges et al., taken alone or in any proper combination, fail to disclose or suggest Applicant's claimed invention.


Therefore, for at least the reasons given above, Claim 21 is believed to be patentably distinct and allowable over the cited prior art references. Accordingly, Applicants respectfully request withdrawal of the rejections with respect to Claim 21 under 35 U.S.C. § 103(a) over Van Den Heuvel et al. in view of Bridges et al. and further in view of Gourgue et al.

CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 3, 5, 8 – 10, 16 – 18, 20 – 21, 25, 28 – 29 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



Paul J. Esatto, Jr.
Registration No. 30,749

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza - Ste. 300
Garden City, New York 11530
(516) 742-4343

PJE:DAT:jam